

### **REMARKS**

In the Office Action mailed on August 19, 2004, the Examiner rejected claims 1-4, 6-13, 15-26, and 28-30. Claims 9 and 28 have been amended and claims 31-33 have been added. Upon entry of the amendments, claims 1-4, 6-13, 15-26, and 28-33 will remain pending in the present application. Applicant respectfully requests reconsideration of the rejections and allowance of all pending claims.

### **Improper Finality of Office Action**

Applicant respectfully asserts that the August 19, 2004 Office Action was improperly made final. According to M.P.E.P. § 706.07(h), “[t]he action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.” Those conditions state that it is only proper to make a first office action when the application “would have been properly finally rejected on the *grounds and art of record* in the next Office action if they had been entered in the earlier application.” M.P.E.P. § 706.07(b) (emphasis added). Because the most recent Office Action introduced the Wagner reference (U.S. Patent No. 4,193,434) for the first time, it was improper for the most recent Office Action to be made final. Further, Applicant’s Attorney spoke with the Examiner on November 22, 2004, and the Examiner agreed that the Office Action should not have been made final. For these reasons, Applicant respectfully requests that the Examiner remove the finality of this Office Action.

### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-4, 6-13, and 15-26 as being unpatentable over the Wagner (U.S. Patent No. 4,193,434) in view of Bernoni (U.S. Patent No. 5,584,628). In the Office Action, the Examiner rejected claims 28-30 as being unpatentable over Wagner in view of Bernoni and further in view of Applicant’s admitted prior art.

***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a *convincing line of reasoning* as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Second, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “*well within the ordinary skill of the art*” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Third, it is improper to combine references when the combination requires substantial reconstruction or redesign of the main reference to arrive at the claimed invention. *In re Ratti*,

123 U.S.P.Q. 349 (C.C.P.A. 1959). Similarly, it is improper to combine two references when the combination would “change the basic operating principles under which [the main reference]...was designed to operate.” *Id.* at 352. Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *see* M.P.E.P. §2143.01. Lastly, it is also improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145.

Fourth, if the Examiner believes that certain features or equivalents are well known in the prior art, then Applicant hereby seasonably traverses and challenge the Examiner’s position and request evidence in support of the Examiner’s position as soon as practicable during prosecution. *See* M.P.E.P. § 2144.03 and § 2144.06.

#### ***Claims 1-4, 6-8, and 15-26***

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness against independent claims 1, 15, and 21 as well as the claims that depend therefrom because the Examiner has failed to present a convincing line of reasoning for finding the claimed invention obvious in light of the cited references.

First, the Examiner has failed to provide *any objective evidence* of the requisite motivation or suggestion to combine or modify the cited references. Rather, the Examiner has relied upon statements such as “the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining an internally threaded fastener in Wagner.” Office Action, page 2, lines 18-22. Applicant reminds the Examiner that there is no internally threaded fastener in Wagner. This is a feature that the Examiner improperly borrowed from the Bernoni reference. Further, even assuming for the sake of

argument that the Wagner reference could work with an internally threaded fastener, the Examiner has presented *no objective evidence* that one of ordinary skill would be motivated or suggested to modify the Wagner reference as proposed by the Examiner. As such, the Examiner's statement is no more than a conclusory statement that the modification would have been well known in the art. However, as stated above, this type of statement is not legally sufficient to meet the Examiner's burden to establish a *prima facie* case. See *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, Applicant respectfully disputes the Examiner's statement that "at the time of the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Wagner with an internally threaded fastener in view of the teaching of Bernoni." Office Action, page 2, lines 12-17. As stated above, if the Examiner believes that certain equivalents are well known in the prior art, then Applicant hereby seasonably traverses and challenge the Examiner's position and request evidence in support of the Examiner's position as soon as practicable during prosecution. See M.P.E.P. § 2144.03 and § 2144.06. Applicant stresses that the ability of different fasteners to be used with one reference does not imply that these fasteners are equivalent, nor does it mean that these different fasteners are exchangeable with one another in different systems. Some systems and devices, such as disclosed by Wagner, are only workable with one type of fastener, e.g., a bolt. Accordingly, an internally threaded fastener cannot be exchanged with the bolt of Wagner.

Third, the proposed combination of the Wagner reference and the Bernoni reference so alters the Wagner reference as to amount to impermissible "substantial reconstruction and redesign of the elements." See *In re Ratti*, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959). In particular, the Wagner reference is directed towards a "preassembled bolt and washer-like device." Abstract, line 1. The Examiner's proposed modification of the Wagner reference would involve replacing the bolt 10 with an internally threaded fastener and greatly modifying the washer 12 to such an extent that even the Examiner was forced to admit that the washer would not function as

intended by the Wagner reference. *See* Office Action, page 5, lines 1-5. Clearly, replacing or greatly modifying each of the two major components of the assembly in the Wagner reference amounts to “substantial reconstruction.” As such, it is clearly improper for the Examiner to combine the Wagner reference and the Bernoni reference.

Fourth, the cited references actually *teach away* from the combination. As the Examiner himself admits in the Office Action, “once the bolt [10 from the Wagner reference] is replaced, the currently employed retaining means [the limited axial extent annular ledge 32] would be *inoperative* requiring a new retaining means.” Office Action, page 5, lines 1-5 (emphasis added). In light of this admission by the Examiner, Applicant respectfully reminds that Examiner that if the proposed modification renders the prior art invention being modified *unsatisfactory or inoperable* for its intended purpose, then *there is no suggestion or motivation* to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For this reason alone, it was improper for the Examiner to combine the Wagner reference with the Bernoni reference.

Fifth, removing the limited axial extent annular ledge 32 also renders the Wagner reference inoperable for its intended purpose because the retaining means from the Bernoni reference cannot be “snappingly preassembled” with the internally threaded fastener borrowed the Bernoni reference. As stated in the Wagner reference, one of the primary features and objects of the invention of the Wagner reference is that the washer 12 and the bolt 10 “may be snappingly preassembled to one another and yet be free spinning.” *See* col. 1, lines 57-58 (emphasis added). This snapping is an important part of the assembly process. Specifically, as stated in the Wagner reference, “the washer unit 12 is preassembled to the bolt 14 by telescopically associating one with the other and snappingly engaging the ledge 22 on the bolt beneath annular protuberance 32 on the washer.” Col. 3, lines 35-38 (emphasis added). If one skilled in art were to modify the Wagner reference in the manner suggested by the Examiner,

the Wagner reference would clearly not function as intended. For this reason as well, it was improper for the Examiner to combine the Wagner reference with the Bernoni reference.

Sixth, Applicant respectfully asserts that the Examiner has not met his burden to establish a *prima facie* case of obviousness, because the Examiner has used impermissible hindsight to reconstruct the invention. Applicant reminds the Examiner that the Examiner must present a convincing line of reasoning as to why an artisan of ordinary skill in the art, viewing only the collective teachings of the references, would find it obvious to combine elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As noted above, the Examiner has simply provided a conclusory statement as support for combining the cited references. Specifically, as support for the reference combination, the Examiner merely stated that “[a]t the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Wagner with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally threaded fastener.” Page 2, lines 13-16. However, the Examiner’s assertion of obviousness fails to demonstrate elements in the cited references that would buttress this conclusion. Further, Applicant notes that it is hardly surprising that the Bernoni reference would disclose “applications requiring an internally threaded fastener,” as stated by the Examiner because the Bernoni reference discloses an internally threaded fastener. A statement that a reference can be used for its regular function clearly does not constitute a motivation to combine it with an unrelated reference. Without support from either

of the cited references, the Examiner has, at best, employed impermissible hindsight reconstruction to reject the instant claims. That is, the Examiner has employed the teachings of the instant application as a guide for combining the cited references to reach the instant claims. Accordingly, the Examiner has failed to provide a *prima facie* case of obviousness.

For all of the reasons set forth above, Applicant respectfully asserts that claims 1-4, 6-8, and 15-26 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

***Claims 9-13 and 28-33***

As discussed further below, Applicant respectfully asserts that the combination of the Wagner reference and the Bernoni reference does not disclose all of the recited features of claims 9-13 and 28-33. Further, as discussed above with reference to claims 1-4 and 6-8, Applicant stresses that the Examiner has not established a *prima facie* case to combine the Wagner reference and the Bernoni reference. Therefore, Applicant respectfully requests withdrawal of the Examiner's rejections under 35 U.S.C. § 103(a).

Amongst other things, independent claim 9, as amended, recites "[a]n internally threaded fastener assembly comprising... a threaded bolt mated to the threaded nut, wherein the shaft of the threaded bolt extends through the standoff portion and a head of the threaded bolt abuts an outer end of the standoff portion at an outer end opposite from the washer portion." Similarly, claim 28 recites "an externally threaded fastener matingly engaged with the internally threaded fastener, the externally threaded fastener including a head... wherein the head abuts an outer end of the standoff portion at an outer end opposite from the spring washer portion, such that the standoff portion limits compression of the internally and externally threaded fasteners about the first and second members." New claims 31-33 contain similar limitations directed towards independent claims 1, 15, and 21. In sharp contrast, neither the Wagner reference nor the Bernoni reference discloses these features. Simply put, even if one were to modify the



Wagner reference as suggested by the Examiner, a threaded fastener (i.e., a nut or bolt) would not abut the lowermost extremity 34 of the sleeve 30. In sharp contrast, the lower support structure 44 would be disposed adjacent the sleeve 30. For this reason alone, Applicant respectfully requests the allowance of claims 9-13 and 28-33.

In addition, for each of the reasons stated above with regard to independent claims 1, 15, and 21, Applicant stresses that the Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness. Furthermore, with respect to the Examiner's citation from the present application's disclosure, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the Examiner is relying on Applicant's disclosure to provide the motivation to combine, and this is improper.

For each of the reasons set forth above, Applicant respectfully requests the withdrawal of the rejections and allowance of claims 9-13 and 28-33.

#### **PETITION FOR EXTENSION OF TIME**

Applicant hereby requests a one-month extension in the statutory period for response to the Office Action from November 19, 2004 to December 19, 2004 in accordance with 37 C.F.R. § 1.136. The Commissioner is authorized to charge the requisite extension fee of \$120.00, and any additional fees which may be required, to the credit card listed on the attached PTO-2038.

However, if the PTO-2038 is missing, if the amount listed thereon is insufficient, or if the amount is unable to be charged to the credit card for any other reason, the Commissioner is authorized to charge Deposit Account No. 06-1315; Order No. ITWO:0026/YOD (13411-70).

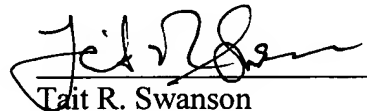


**Conclusion**

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: December 9, 2004

A handwritten signature in black ink, appearing to read "Tait R. Swanson", is written over a horizontal line.

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